



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/569,018	02/23/2006	Gerhardus Engbertus Mekenkamp	NL 031039	1654
24737 7590 08/08/2007 PHILIPS INTELLECTUAL PROPERTY & STANDARDS P.O. BOX 3001 BRIARCLIFF MANOR, NY 10510			EXAMINER JACOB, AJITH	
			ART UNIT 2169	PAPER NUMBER
			MAIL DATE 08/08/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/569,018

Applicant(s)

MEKENKAMP ET AL.

Examiner

Ajith Jacob

Art Unit

2169

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 February 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 February 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>2/06, 5/07</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The instant application having Application No. 10/569018 has a total of 13 claims pending in the application, there are 3 independent claims and 10 dependent claims, all of which are ready for examination by the examiner.

Oath/Declaration

2. The applicant's oath/declaration has been reviewed by the examiner and is found to conform to the requirements prescribed in **37 C.F.R. 1.63**.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 8-13 are directed towards software, *per se*. The claims lack the necessary physical articles or objects to constitute a machine or a manufacture within the meaning of 35 USC 101. They are clearly not a series of steps or acts to be a process nor are they a combination of chemical compounds to be a composition of matter. As such, they fail to fall within a statutory category. They are, at best, functional descriptive material *per se*. Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." Both types of "descriptive material" are nonstatutory when claimed as descriptive material *per se*, 33 F.3d at 1360, 31 USPQ2d at 1759. When functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare *In re Lowry*, 32 F.3d 1579,

1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994). Merely claiming nonfunctional descriptive material, i.e., abstract ideas, stored on a computer-readable medium, in a computer, or on an electromagnetic carrier signal, does not make it statutory. See *Diehr*, 450 U.S. at 185-86, 209 USPQ at 8 (noting that the claims for an algorithm in *Benson* were unpatentable as abstract ideas because "[t]he sole practical application of the algorithm was in connection with the programming of a general purpose computer.").

4. Claim 8 is a control software claim that describes its use on a data processing system, but does not specify a physical piece of hardware to fulfill the claim, and thus has been rejected.

5. Claims 9-12 does not solve any of the non-statutory deficiencies of claim 8, and thus are rejected for the reasons stated above.

6. Claim 13 is a data processing system enabling access to a file, but does not describe the system comprising of any hardware, and thus has been rejected.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-6, 8-11 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Ofek et al. (US 6,108,748).

For claim 1, Ofek et al. teaches:

A method of enabling access to a specific file on a data processing system, the method comprising:
maintaining a history regarding migration of the specific file on the system [data client map, column 2, lines 45-54]; and upon access of a specific link representative of a pointer to a particular location associated with the specific file in a time period covered by the history, determining a current location of the specific file based on the history [pointer from data map or table determines the location of the data, column 2, lines 45-54].

For claim 2, Ofek et al. teaches:

The method of claim 1, comprising updating the specific link to be representative of the current location [data map updated after first access, column 2, lines 55-61].

For claim 3, Ofek et al. teaches:

The method of claim 2, comprising updating the specific link upon the access of the specific link [first access places data into location and data map updates, column 2, lines 55-61].

For claim 4, Ofek et al. teaches:

The method of claim 1, comprising maintaining a list of respective further files comprising respective links to the specific file [setting of attribute flag to keep track of further reads to stored data, column 8, lines 25-67].

For claim 5, Ofek et al. teaches:

The method of claim 4, comprising updating the respective links so as to be

representative of the current location [link updated if not searched for before or flag bit gets set, column 8, lines 25-67].

For claim 6, Ofek et al. teaches:

The method of claim 5, wherein the updating is carried out upon access of the specific link [flag updated upon access to link, column 8, lines 25-67].

7. The method of claim 1, wherein:

the data processing system is compliant with UPnP; and

the history is maintained in a Content Directory Service.

Claim 8 is a software product of claim 1. Ofek et al. teaches the limitations of claim 1 for the reasons stated above.

Claim 9 is a software product of claim 4. Ofek et al. teaches the limitations of claim 4 for the reasons stated above.

Claim 10 is a software product of claim 5. Ofek et al. teaches the limitations of claim 5 for the reasons stated above.

Claim 11 is a software product of claim 6. Ofek et al. teaches the limitations of claim 6 for the reasons stated above.

Claim 13 is a system of claim 1. Ofek et al. teaches the limitations of claim 1 for the reasons stated above.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

11. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ofek et al. as set forth above against claim 1 above, and in view of Rasheed et al. (US 2004/0064575 A1).

As per claim 1, Ofek et al. teaches the history of specific file being stored [column 2, lines 45-54], but does not teach compliancy with Universal Plug-and-Play (UPnP) standard and the maintenance of the history in a Content Directory Service.

Rasheed et al. teaches the use of the UPnP architecture for retrieval of data [0019] and the Content Directory Service for providing a listing of the data.

Ofek et al. (US 6,108,748) and Rasheed et al. (US 2004/0064575 A1) are analogous art because they are from the same field of endeavor of data transfer.

At the time of the invention it would have been obvious to a person of ordinary skill in the art to modify the data processing system described by Ofek et al. and add the UPnP architecture with a Content Directory Service as described by Rasheed et al.

The motivation for doing so would have been to have "a device that is capable of discovering and controlling services on other devices" [0004].

Therefore, it would have been obvious to combine Ofek et al. (US 6,108,748) with Rasheed et al. (US 2004/0064575 A1) for the benefit of plug-and-play and easy search of file location history.

12. Claim 12 is a software product of claim 7. Ofek et al. teaches the limitations of claim 7 for the reasons stated above.

Conclusion

The Examiner requests, in response to this Office action, that support be shown for language added to any original claims on amendment and any new claims. That is, indicate support for newly added claim language by specifically pointing to page(s) and line no(s) in the specification and/or drawing figure(s). This will assist the Examiner in prosecuting the application.

When responding to this Office action, Applicant is advised to clearly point out the patentable novelty which he or she thinks the claims present, in view of the state of the art disclosed by the references cited or the objections made. He or she must also show how the amendments avoid such references or objections See 37 CFR 1.111(c).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ajith Jacob whose telephone number is 571-270-1763. The examiner can normally be reached on M-F 7:30-5:00 EST, Every other Friday off.


Art Unit: 2169

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mohammad Ali can be reached on 571-272-4105. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

8/1/2007

KBP


MOHAMMAD ALI
PRIMARY EXAMINER

AJ

AJ
Patent Examiner